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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,634	12/04/2000	Douglas J. Woodnorth	08935-226001 / M-4934	3041

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EXAMINER	
BORISSOV, IGOR N	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/729,634	WOODNORTH, DOUGLAS J.	
	Examiner	Art Unit	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-9,13-20 and 44-53* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-9,13-20 and 44-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Examiner's Note

Examiner suggests to substitute a phrase "*communicating a bill*" in claim 5 with "*communicating bill information*"; and a phrase "*bill is communicated*" in claim 6 with "*bill information is communicated*".

Claim Rejections under 35 USC § 112 have been withdrawn due to the applicant's amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5, 7-8, 13-15, 17-20, 46-51 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta (US 5,349,535) in view of Koenck (US 4,961,043).

Independent Claim.

Claim 14. Gupta teaches a vehicle battery condition monitoring and recording method and system, comprising:

Providing a battery to a user to be used in a user's device (a car) (C. 5, L. 14-36); determining the usage of the battery; determining a fee based on the usage (C. 3, L. 47-50).

Gupta does not specifically teach that said battery is a portable battery, and that said user's device is a hand-portable device.

Koenck teaches a method and system for monitoring battery condition, said battery used in hand-held devices, wherein charging operation can be based on the use history and/or other relevant information concerning the specific battery means (C. 2, L. 16-22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta to include that said battery is used for powering a user's hand-portable devices, as disclosed in Koenck, because it would advantageously increase the application field of the invention, thereby generate more revenue.

Dependent Claims.

Claim 5. Communicating usage information, said information is used for billing (Gupta; C. 10, L. 28-35).

Claims 7-8. Providing the customer with option to purchase the battery, or to lease it. Leasing option inherently indicates absence of purchase fee (Gupta; C. 3, L. 29-30).

Claim 13. Said method and system, wherein the battery usage is based on recharge cycles (Gupta; C. 7, L. 31-36, 42-43, 48-49).

Claim 15. See **claim 14.**

Claim 17. See **claim 14.**

Claim 18. Providing a plurality of charging stations, where the fee for replacement or recharging is based on the usage and/or said terms (Gupta; C. 9, L. 55-58; C. 11, L. 30-45).

Claim 19. See **claim 14.**

Claim 20. Providing a battery for a device (Gupta; C. 5, L. 14-36). Information as to *single-use* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-

functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Gupta in view of Thandiwe would be performed the same regardless of the type of said portable battery.

Claim 46. Providing a battery for a device (Gupta; C. 5, L. 14-36). Information as to *power tool* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claim 47. Providing a battery for a device (Gupta; C. 5, L. 14-36). Information as to *personal care product* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claim 48. Providing a battery for a device (Gupta; C. 5, L. 14-36). Information as to *electric razor* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claim 49. Providing a battery for a device (Gupta; C. 5, L. 14-36). Information as to *the personal care product is an electric toothbrush* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claim 50. Providing a battery with a device (car) (Gupta; C. 9, L. 14-37).

Claim 51. See claim 14.

Claim 53. Providing a rechargeable battery for a device (Gupta; C. 5, L. 14-36).

Claims 6, 9, 16, 44-45 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Koenck and further in view of Segal et al. (US 6,167,251) (Segal).

Claims 6 and 16. Gupta in view of Koenck teaches all the limitations of claims 6 and 16, except specifically teaching that said information is transmitted over the Internet.

Segal teaches a method and system for a cellular phone, said phone typically has either an internal energy supply and storage for pre-paid communication units, or a removable airtime cartridge, containing an energy supply and either the ability to store or to generate a set of pre-paid single use airtime communication units, wherein said phone is configured to establish an Internet connection (C. 10, L. 7-12; C. 11, L. 37-38).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gupta in view of Koenck to include that said information is transmitted over the Internet, as indicated in Segal, because it would advantageously allow to make the information instantly available at any remote location adapted to be connected to the Internet.

Claims 9 and 44. Segal teaches said method and system, wherein the device is a communication device (telephone) (C. 10, L. 7-12). The motivation to combine Gupta and Koenck with Segal would be to advantageously increase the application field of the invention, thereby generate more revenue.

Claim 45. Segal teaches that the use of a portable laptop computer in communication with said phone (C. 34, L. 65). The motivation to combine Gupta and Koenck with Segal would be to advantageously increase the application field of the invention, thereby generate more revenue.

Claim 52. Segal teaches said method and system, wherein the portable power source is a battery (See claim 9).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

IB
12/13/2004